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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,432	10/02/2000	James B. McCarthy	110.01130101	3387

7590

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Ann M Mueting
Mueting Raasch & Gebhardt
PO Box 581415
Minneapolis, MN 55458-1415

EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/600,432

Applicant(s)
McCarthy

Examiner
David Lukton

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 19, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

- G1:** The peptide consists of six amino acids;
- G2:** The peptide consists of less than six amino acids;
- G3:** The peptide consists of "about ten" amino acids, but no less than 10 amino acids;
- G4:** The peptide consists of less than 10 amino acids, with the proviso that subgenera G1, G2 and G3 are excluded;
- G5:** The peptide consists of "about 50" amino acids, but no less than 50 amino acids;
- G6:** The peptide consists of less than 50 amino acids, with the proviso that subgenera G1 - G5 are excluded.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-11, drawn to peptides, limited to G1.
2. Claims 1-11, drawn to peptides, limited to G2.
3. Claims 12-14, drawn to peptides, limited to G3.
4. Claims 12-14, drawn to peptides, limited to G4.
5. Claims 15-21, drawn to peptides, limited to G5
6. Claims 15-22, drawn to peptides, limited to G6.
7. Claim 23, drawn to a method of using the peptides of Group 1.
8. Claim 23, drawn to a method of using the peptides of Group 2.

9. Claim 23, drawn to a method of using the peptides of Group 3.
10. Claim 23, drawn to a method of using the peptides of Group 4.
11. Claim 23, drawn to a method of using the peptides of Group 5.
12. Claim 23, drawn to a method of using the peptides of Group 6.

[The term "having", when applied to one of the claimed peptide sequences, is interpreted to mean either of the following: (a) the claimed peptide *consists* of the indicated sequence, or (b) an amino acid or peptide may be bonded to the N-terminus of the indicated sequence].

Inventions 1-6 are distinguished primarily on the basis of the size of the peptide. Clearly, a hexapeptide is distinct from a 50-amino acid peptide, and *vice versa*.

Inventions 1-6 and 7-12 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). However, in the event that applicants elect any of Groups 1-6, and claims therein found allowable, the method-of-use claim will be rejoined for further examination.

The "371" status of the application is noted. However, it is the assertion of the examiner that not all embodiments of the claimed invention "define a contribution" over the prior art. In the event that evidence to this effect can be produced, applicants will not enjoy

“immunity” from restriction.

Notwithstanding the foregoing, it is suggested that applicants indicate a second and third choice for group to be rejoined. The possibility of rejoining will be considered, in the event that the elected group proves to be novel.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

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In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a single disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific peptide which **consists of** a particular amino acid sequence. (A peptide “having” or “comprising” a given sequence is not a “specie”).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention. Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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Serial No. 09/600,432
Art Unit 1653

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton [phone number (703)308-3213].

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800